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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,873	08/05/2003	Alice H. Howe	MPH 03-13	9057
27990	7590	07/26/2004	EXAMINER	
M. PAUL HENDRICKSON 403 MAIN STREET, P.O. BOX 508 HOLMEN, WI 54636-0508			CHIU, RALEIGH W	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/635,873	HOWE, ALICE H.
	<b>Examiner</b>	<b>Art Unit</b>
	Raleigh Chiu	3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4 and 6-15 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. ____ .   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____ .                                   |

**DETAILED ACTION**

**Priority**

1. It is noted that the Serial Number listed in the preliminary amendment filed 20 August 2003 to which applicant desires priority is incorrect.

**Claim Rejections - 35 USC § 103**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 4, 6, 7, 9, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 4,834,393 (Feldi) or French Patent Number 2,594,037 (Musslin) and either in view of (Melbye et al., hereinafter Melbye) and applicant's admission of prior art in the specification.

Regarding claims 1, 4, 6, 9, 10 and 12, Figure 1 of Feldi discloses a tennis racquet 1 with a ball retrieving attachment 2 attached to the racquet shoulder. Feldi further discloses the

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ball retrieving attachment to be made from a hook-and-loop fastening system, specifically Velcro™.

Figures 1-3 of Musslin also show a ball retrieving attachment attached to the shoulder of a tennis racquet where the retrieving attachment is made from a hook-and-loop fastener.

Combining the fact that the Feldi abstract discloses that any hook-and-loop fastener system could be used in combination with his racquet or that Musslin discloses the broad recitation of a hook-and-loop fastener in combination with a racquet, with the fact that Melbye at column 1, lines 15-23 discloses that Velcro™ and Scotchmate™ products are functional equivalents as hook-and-loop fasteners, and the with the fact that applicant admits in the specification that the materials with the physical characteristics set forth in the claims are old and well-known Scotchmate™ hook-and-loop products, the selection of any of these known materials to form the hook-and-loop fastener of either Feldi or Musslin would be within the level of ordinary skill in the art.

With further regard to claim 1, Figure 1 of Feldi and Figure 3 of Musslin show the racquet in tangential contact with a tennis ball.

With further regard to claim 10, although Feldi intends to provide an entirely new covering on a tennis ball, he also notes

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that it is old and well-known in the tennis art to pick up a standard tennis ball with a hook material affixed to the end of a tennis racquet. See column 1, lines 15-25. Further, as Musslin does not disclose the concept of covering the tennis balls with a different material, the Musslin racquet is considered to be used with standard tennis balls.

4. Claims 8, 11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldi, Musslin, Melbye and applicant's admission of prior art in the specification as applied above in view of U.S. Patent Number 4,993,712 (Urwin).

Regarding claims 8, 11 and 13-15, it would have been obvious to one of ordinary skill in the art to place the ball retrieving attachment between the three and nine o'clock positions of the Feldi racquet shoulder as modified above in view of Urwin who teaches at column 4, lines 8-13 that a ball retrieving attachment comprised of hook-and-loop fasteners can be placed anywhere along the outer surface of the racquet frame.

#### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.

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Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 4 and 6-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of co-pending Application No. 09/655,743. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same essential limitations of a specific hooked fastener material attached to the shoulder of a racquet are being claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh

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Chiu whose telephone number is (703) 308-2247. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on (703) 308-1513.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu  
Primary Examiner  
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RWC:dei:feif  
22 July 2004